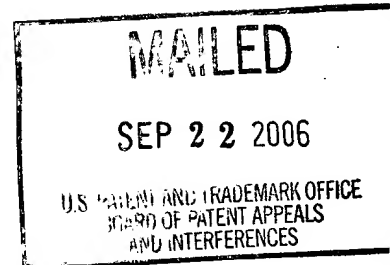


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CHARLES RICCI, BART DOLMATCH,
ANDREW H. CRAGG, and RICHARD J. GREFF



Appeal No. 2006-2879
Application No. 09/954,789

ON BRIEF

Before MILLS, GRIMES, and LINCK, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16 and 20-32.

Claims 16 reads as follows:

16. A kit of parts for use in sealing endoleaks arising from endovascular repair of an aneurysm which comprises:

- (a) a fluid composition which forms a coherent mass in the presence of blood which mass adheres to the vascular surface and/or surface of the endovascular prosthesis wherein said fluid composition comprises a biocompatible solvent and a biocompatible polymer;
 - (b) a catheter suitable for delivering the fluid composition to an endoleak site formed from endovascular repair of an abdominal aortic aneurysm;
 - (c) a catheter suitable for delivering an endovascular prosthesis to the aneurysm;
- and

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(d) an endovascular prosthesis comprising a stent graft capable of inhibiting but not completely arresting blood flow into the abdominal aortic aneurysm due to the presence of one or more endoleaks.

The prior art references cited by the examiner are:

McCrory	5,951,599	Sept 1999
Evans et al. (Evans)	5,695,480	Dec. 1997

Chuter et al. (Chuter), "Endovascular Aneurysm Repair in High-Risk Patients", J. Vasc. Surg., Vol. 31, pp. 122-133 (2000)

May et al. (May), "Comparison of First and Second Generation Prostheses for Endoluminal Repair of Abdominal Aortic Aneurysms: A 6-year Study with Life Table Analysis," J. Vasc. Surg., Vol. 32, pp. 124-129 (2000)

Grounds of Rejection

Claims 16, and 20-32 stand rejected under 35 U.S.C. § 103(a) over McCrory in view of Chuter, May and Evans.

We reverse this rejection.

DISCUSSION

Obviousness

Claims 16, and 20-32 stand rejected under 35 U.S.C. § 103(a) over McCrory in view of Chuter, May and Evans.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). An obviousness analysis requires that the prior art both suggest the claimed subject matter and reveal a reasonable expectation of success to one reasonably skilled in the art. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

According to the examiner (Answer, pages 4-5)

The instant claims are directed to kits comprising a fluid composition that forms a coherent mass in the presence of blood comprising a biocompatible solvent and a biocompatible polymer, a catheter suitable for delivering the fluid composition, a catheter suitable for delivering an endovascular prosthesis to the aneurysm, and an endovascular prosthesis comprising a stent-graft. McCrory teaches occlusive systems including a stent for deployment in the parent vessel, a catheter for insertion of the device, a liquid polymeric embolizing composition to seal aneurysm sac and a microcatheter to deliver the embolizing composition (see abstract, col 3, lines 60-col 4, lines 24; col 5, lines 25-58; col 6, lines 15-60 and figures 6A-B; col 8, line 50-col 9, line 20; col 12, lines 13-25). The stent of McCrory is an endovascular prosthesis. The composition of McCrory meets the element (a) of the instant claims because a liquid embolizing compositions comprises a biocompatible polymer and solvent. McCrory does not teach stent-grafts.

To make up for the deficiencies of McCrory, the examiner relies on Chuter and May. According to the examiner, these references "collectively teach that stent-grafts and stents are interchangeably used in the art to treat vascular aneurysms." Answer, page 5. Additionally, Evans is relied on to show "assembling a kit for vascular repair procedure[s] comprising an embolic

polymeric composition, which solidifies in vivo." Id.

The examiner concludes it would have been obvious to add a stent-graft taught by Chuter and May to McCrory's system and assemble a kit to facilitate convenience during a vascular repair procedure as taught by Evans. The examiner additionally relies on In re Kerkhoven, 205 USPQ 1069 (CCPA 1980), for the legal proposition that it would have been obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition for the same purpose. Answer, page 5.

Appellants argue, however, that neither Chuter nor May constitute prior art against the claimed invention. Brief, page 5. Appellants argue that they are entitled to the filing date of March 19, 1999, which is prior to the 2000 publication dates of Chuter and May. Further, appellants argue that Example 2 of the priority application (09/273,120 ('120), now U.S. Patent No. 6,203,779 B1 ('779)) describes the use of a Wallgraft™, which is a stent-graft, evidencing support for stent-grafts in the priority application. The examiner counters that the March 19, 1999 filing date does not envision the use of stent-grafts in their kits. We disagree.

Upon review of the disclosure of the '120 application as reproduced in the '779 patent, we agree with appellants that the priority application describes stent-grafts. In our view, example 2 of the '120 application describes the use of a

stent-graft, i.e., Wallgraft™. Declaration evidence of record, Declaration of Richard J. Greff, PhD., paragraph 10, dated January 22, 2003, would reasonably appear to establish that persons of ordinary skill in the art understood that a Wallgraft™ is also known as a stent-graft. See Amendment filed May 21, 2003 and accompanying Declaration. In addition, the specification of the '120 application (as evidenced by the '779 patent, column 2, lines 11-22), incorporates by reference a publication by Parodi, referencing stent-grafts. Thus, the '120 application would reasonably appear to support the disclosure of stent-grafts and May and Chuter are not prior art to the present application. The rejection over McCrory taken with May, Chuter, and Evans is reversed.

Other Issue for Consideration

Upon return of the application to the examiner, the examiner should consider the following. Appellants' specification, page 18, lines 7-14, states, "[s]uitable endovascular prostheses for endovascular repair of abdominal aortic aneurysms are well known in the art and are described, for example, by Beebe[]. Such prostheses, by themselves, do not form part of this invention." In addition, the specification, page 3, references the November 1998 publication by Parodi, "Endovascular AAA Stent Grafts: Training and Proper Patient Selection."

These references in the specification would appear to antedate the filing date of March 19, 1999 and evidence that stent-grafts were known in the art at the time

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of filing of the present application.

The merits panel has become aware of an additional Parodi publication dating to 1991 describing the first human trials with stent-grafts. See Parodi, et. al, "Transfemoral intraluminal graft implantation for abdominal aortic aneurysm," Ann. Vasc. Surg. pp. 491-499 (1991). Moreover, an additional reference already of record, Holzenbein, "Endovascular Management of Endoleaks After Transluminal Infrarenal Abdominal Aneurysm Repair," Eur. J. Vas. Endovac. Surg., Vol. 16, pp. 208-217 (1998), also references the availability and use of stent-grafts as of the filing date of the present application.


The examiner is encouraged to review these as well as other publications of record in the application to determine if they would support a rejection of the pending claims for obviousness in combination with McCrory and Evans or other appropriate reference. Any new rejection of the claims should address and analyze appellants' argument and evidence of record that grafts and stent-grafts were not recognized as being interchangeable by those of ordinary skill in the art.

CONCLUSION

The rejection of claims 16, and 20-32 under 35 U.S.C. § 103(a) over McCrory in view of Chuter, May and Evans is reversed. The application is remanded to the examiner to consider the other issues raised herein.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(D) (8th ed., rev. 1, February 2003). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED AND REMANDED



Demetra J. Mills
Administrative Patent Judge



Eric Grimes
Administrative Patent Judge



Nancy Linck
Administrative Patent Judge

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